

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEPHEN W. COMISKEY
AND BARRETT O. COMISKEY

Appeal 2007-1182
Application 10/020,136
Technology Center 1700

Decided: May 21, 2007

Before EDWARD C. KIMLIN, CHUNG K. PAK, and PETER F. KRATZ,
Administrative Patent Judges.

KIMLIN, *Administrative Patent Judge.*

DECISION ON APPEAL

This is an appeal from the final rejection of claims 21-40. Claim 21 is illustrative:

21. A method of reducing reflected light glare into a human's eyes from the human's cheeks, the method comprising the steps of:

applying underneath the human's eyes, on the human's cheeks, generally covering a location at which incident direct or indirect light is

likely to be reflected in the human's eyes, a non-toxic material having a non-reflective colored and finished exterior surface having a wavelength falling outside of the range of wavelength between 430 nm and 690 nm, and a shape formed within the exterior surface, wherein the shape has a color contrasting to the non-reflective color and is configured to provide communication, and wherein the non-toxic material comprises one of a decal and a temporary tattoo; and

removing the non-reflective material within a week after application of the non-reflective material.

The Examiner relies upon the following references as evidence of obviousness:

Essig	US 1,300,592	Apr. 15, 1919
Humason	US 4,522,864	Jun. 11, 1985
Micchia	US 4,719,909	Jan. 19, 1988
Ross	US 5,470,351	Nov. 28, 1995

Appellants' claimed invention is directed to a method of reducing light glare that is reflected into a human's eyes. The method entails applying on the human's cheeks a non-reflective colored exterior surface having a shape formed within the exterior surface. The shape has a color contrasting to the non-reflective color of the exterior surface. The applied material is a decal or temporary tattoo.

The appealed claims stand rejected under 35 U.S.C. § 103(a) as follows:

- (a) claims 21-24 and 31-34 over Micchia in view of Essig,
- (b) claims 26-30 and 36-40 over the stated combination of references further in view of Ross,
- (c) claims 25 and 35 over Micchia in view of Essig and Humason.

Appellants submit at page 4 of the Brief that "[n]one of the claims stand or fall together." However, Appellants do not set forth different substantive arguments for the various claims on appeal, including the claims separately rejected by the Examiner over the additional disclosures of Ross and Humason. Pages 16-24 of Appellants' Brief are devoted to recitations in different claims on appeal, but no separate substantive arguments are presented for any of these claims. Rather, Appellants repeat that the "rejection of this claim is improper for the reasons set forth above with respect to claim 21," and with the conclusory remark that the combination of references fails to show each and every limitation of the particular claim. Accordingly, all the appealed claims stand or fall together with claim 21.

We have thoroughly reviewed each of Appellants' arguments for patentability. However, we find ourselves in complete agreement with the Examiner's reasoned analysis and application of the prior art, as well as the cogent disposition of the arguments raised by Appellants. Accordingly, we will adopt the Examiner's reasoning as our own in sustaining the rejections of record, and we add the following for emphasis only.

There is no dispute that Micchia, like Appellants, discloses a method of reducing reflective light glare into a human's eyes from the human's cheeks by covering a location at which incident direct or indirect light is likely to be reflected in the human's eyes with a non-toxic material having a non-reflective colored exterior surface. As appreciated by the Examiner, the light absorbing patch of Micchia does not have a shape within its exterior surface having a color which contrasts with the non-reflective color. However, we fully concur with the Examiner that Essig evidences the

obviousness of modifying the design of Micchia's patch such that an interior portion thereof has a contrasting color and is configured to provide communication of some sort. As explained by the Examiner, Essig, directed to a method of forming adhesive, removable decals on the human body, "discloses that where a part of the decal (patch) 4 is to be exposed, it is desirable to impart a particular hue or color [to] the exposed (outer or exterior) part of the decal (page 1, column 1, line 45 to page 1, column 2, line 68) such that the whole surface or only parts of the surface have surface ornamenting material applied thereto" (page 5 of Answer).

Moreover, it is our view that the claimed subject matter would have been obvious to one of ordinary skill in the art in view of Micchia considered alone. Micchia's patch is in the form of a kidney or bean and, therefore, is configured to provide communication of this thought or perception. Also, although the interior portion of Micchia's patch does not have an area with a contrasting color relative to the exterior of the patch, we take official notice of the fact that it is notoriously well known to scribe or write a contrasting pattern or message on a background substrate, either by adding material to the substrate or removing material therefrom. In our view, it would have been a matter of obviousness for one of ordinary skill in the art to add a decorative pattern or message onto Micchia's patch with the understanding that the light absorption of the patch will be compromised or reduced to some extent, depending on the amount of light-absorbing material removed. Manifestly, the black patch of Micchia provides the maximum light absorption and anti-glare effect.

Appellants contend that "the beauty of Essig is purely decorative and fails to provide communication" (page 8 of Br., last para.). However, we fully concur with the Examiner that a purely decorative item "can communicate to the person looking at it [and that] [w]hat the item communicates depends upon who is looking at it" (page 11 of Answer, second para.). Indeed, we will go farther than the Examiner in saying that a decorative item not only *can* communicate to the viewer but necessarily does so. If nothing else, the decoration communicates the image of the decoration itself, not to mention personal thoughts of the viewer associated with the particular image. Also, as noted by the Examiner, Appellants have not defined the claim term "communication" such that it has a meaning other than the dictionary definition of "the exchange of thoughts, messages, or information, as by speech, signals, writing, or behavior" (see page 11 of Answer, first para.).

As noted above, Appellants have not presented separate substantive arguments for the Examiner's separate rejections based on the additional disclosures of Ross and Humason.

As a final point, we note that Appellants base no argument upon objective evidence of nonobviousness, such as unexpected results, which would serve to rebut the inference of obviousness established by the Examiner.

In conclusion, based on the foregoing and the reasons well stated by the Examiner, the Examiner's decision rejecting the appealed claims is affirmed.

Appeal 2007-1182
Application 10/020,136

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(iv)(effective Sept. 13, 2004).

AFFIRMED

CHUNG K. PAK, ADMINISTRATIVE PATENT JUDGE,
CONCURRING.

I fully agree with the majority's view that the Examiner's § 103 rejections should be affirmed. However, I write separately to express an additional reason for affirming the Examiner's § 103 rejections.

As correctly found by the majority:

There is no dispute that Micchia, like Appellants, discloses a method of reducing reflective light glare into a human's eyes from the human's cheeks by covering a location at which incident direct or indirect light is likely to be reflected in the human's eyes with a non-toxic material having a non-reflective colored exterior surface.

Indeed, the Appellants acknowledge at page 1 of the Specification that:

Participants in athletic contest, particularly participants in team sports such as football, soccer, baseball, and lacrosse, that are played outside during the day, or in well lit stadium, minimize the light that is reflected from their cheeks into their eyes by applying conventional eye black to their cheeks. Conventional eye black typically includes as ingredients Vaseline, lanolin, ceresin wax, beeswax, carnauba wax, and black oxide of iron C177499UTV. Eye black may be applied with a finger by dipping it into a large container and wiping on the cheeks under the eye, or applied with a marker in much the same form that lipstick is applied.

As recognized by the Examiner, the light absorbing patch of Micchia does not have "a shape formed within the exterior surface, wherein the shape has a color contrasting to the non-reflective color and is configured to provide communication..." as recited in claim 21 on appeal. According to page 2 of the Specification, this shape configured to provide communication includes, *inter alia*, an advertisement for a sports apparel or equipment manufacturer

or distributor, or a team name, mascot or logo.” It follows that Micchia teaches the claimed method of forming a reflective light glare reducing means, except for placing the claimed printed matter. There is nothing in the record to indicate that the claimed printed matter, such as the advertisement or logo, is any way functionally related to the reflective light glare reducing means. As such, I do not believe that the claimed printed matter (logos or advertisements on the reflective light glare reducing means) is entitled to any patentable weight. As our reviewing court in *In re Ngai*, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004) stated:

As the *Gulack* court pointed out, “[w]here the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability.”

Thus, for the reasons well articulated by the majority and/or the reason set forth above, I would affirm the Examiner’s § 103 rejections.

cam

Appeal 2007-1182
Application 10/020,136

HUNTON & WILLIAMS
Attn: Thomas J. Scott, Jr.
1900 K Street, N.W.
Washington, DC 20006